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Date: April 06, 2006
Subject: Serial No. 09/927,963 (Attorney Docket F-260)

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Page 1 of 14

Attached are the following:

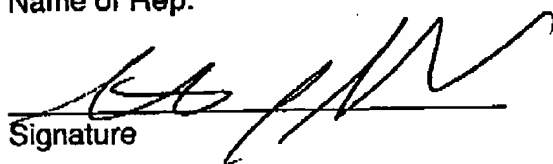
1. Brief on Appeal (13 pages)

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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF APPEALS AND PATENT INTERFERENCES**

In re patent application of:

) Date: April 06, 2006

David K. Lee, et al.

) Attorney Docket No.: F-260

Serial No.: 09/927,963

) Customer No.:00919

Filed: October 10, 2001

) Group Art Unit: 3639

Confirmation No.: 6878

) Examiner: Jon M Bass

Title: METHOD AND APPARATUS FOR TRACKING MAIL ITEMS
 THROUGH A CARRIER DISTRIBUTION SYSTEM

BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is being filed pursuant to 35 U.S.C. Section 134 from the final rejection of claims 1-21 mailed November 04, 2005. Authorization is hereby given to charge deposit account number 16-1885 for all fees required to be paid in connection with this Appeal.

REAL PARTY IN INTEREST

The real party in interest is Pitney Bowes Inc. which acquired all rights to the above-identified application by way of an assignment which was recorded in the Assignment Branch of the United States Patent and Trademark Office on August 10, 2001 at Reel 012084 and Frame 0382.

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RELATED APPEALS AND INTERFERENCES

There are no related Appeals or Interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the instant appeal.

STATUS OF CLAIMS

The instant application was originally filed with claims 1-21. During prosecution no amendments of the claims have been made. Accordingly, claims 1-21 are currently pending and are being appealed.

STATUS OF AMENDMENTS

No Amendments are currently pending. Pending claims 1-21 are set forth in Appendix A.

SUMMARY OF CLAIMED SUBJECT MATTER

The instant summary of the invention is being given by way of example and is not intended to limit the scope of the claims in any manner. By way of background, the instant inventors observed that in many private and postal carrier distribution systems, a number of issues arise with respect to the ability of the sender of an item to track the item within the carrier's system. For example, since carriers typically track the item using a unique carrier assigned number that is applied by the carrier to the item, the sender must have some type of upfront communication with the carrier to obtain the unique carrier assigned number to permit inquiries by the carrier as to the tracking status of the item. Thus, the sender must either 1) physically bring the item to the carrier in order to receive the carrier's unique assigned tracking number, which may take a great deal of time, or 2) obtain such unique numbers from the carrier via some type of electronic communication such as the internet. However, while the online system helps minimize the time problem associated with physically bringing the mailpiece to the carrier, it creates another problem for the carrier in that the carrier cannot be sure

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that the unique carrier generated number was properly affixed to a specific item by the sender.

The instant inventors solved the above problem by using two unique identifiers: one **(13) (paragraph 0014, Fig. 1)** created by the sender and the other **(41) (paragraph 0019, Fig. 3)** created by the carrier. A user generates the unique sender identifier **(13)** during the creation of the mailpiece and submits it into the carrier distribution system, together with the item (i.e. mailpiece) without knowing anything else about the internal workings of the carrier's tracking system **(21) (Paragraph 0019, Fig. 4 step 42, Fig. 2) (inducting step of claim 1)**. The carrier reads obtains knowledge of the sender's unique identifier **(13)** by reading it off of the mailpiece **(Fig 4 step 43 and paragraph 0019) (obtaining step of claim 1)** and then associates the sender's unique identifier with the unique identifier **(41)** created by the carrier that the carrier uses to track the item **(Paragraph 0019) (associating and tracking steps of claim 1)**. Thus, when a sender wishes to check on the tracking status of their item, they only need to provide the sender's unique identifier to the carrier and they don't need to know anything about the carrier's unique identifier **(Paragraph 0024) (allowing step of claim 1)**. The carrier, via the created association between the sender's unique identifier and the carrier's unique identifier, can identify the mailpiece and report the tracking status back to the sender. This system allows for a sender to, for example, drop a mailpiece into a carrier's drop box with a sender's unique identifier located thereon and still be able to track the mailpiece without receiving any unique identifier tracking information from the carrier **(Paragraph 0024)**.

While the above description description applies to independent claim 1, it is equally applicable to apparatus claim 11 which provides the structure for implementing the steps of method claim 1. In claim 11 the means for reading is the **AFC 23 (Fig. 2)**. The means for including the unique carrier generated identifier **(41)** on the mailpiece is the printer **(29) of Fig. 2**. The database that associates the two unique identifiers is shown in **Figure 5 at 47**. And the sensor that captures data is bar code sensor **36 of Figure 2**.

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GROUND OF REJECTION TO BE REVIEWED ON APPEAL

At issue in this Appeal is the propriety of the following rejection:

1. Claims 1-21 stand rejected under 35 U.S.C. 102(e) as being anticipated by O'Callaghan (U.S. Pub No. 2004/0211838).

ARGUMENTS

A rejection for anticipation under section 102 requires that each and every limitation of a claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (fed. Cir. 1994). For the reasons discussed below it is submitted that O'Callaghan fails to teach or suggest each and every limitation of each of claims 1-21.

Claims 1 and 11

O'Callaghan does not teach or suggest the claimed dual use of the unique sender generated identifier and the unique carrier generated identifier as recited in each of independent claims 1 and 11. O'Callaghan is not even directed to the tracking of mailpieces through a carrier distribution system. Instead, O'Callaghan describes the system shown in Figure 2 which verifies whether a batch of mail follows a pre-established set of rules to qualify for bulk mailing discounts (Paragraphs 0005, 0038, claim 1).

As discussed, in paragraphs 0028 and 0036 of O'Callaghan, it is clear that the O'Callaghan system is used by the carrier to verify that information (i.e. # pieces, postage amount, weight) concerning the batch of mail provided by the maller is correct. In 0035 it is stated that:

The system identifies and verifies the accuracy of the printed barcode against the results of an address search within its address database, and

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verifies that such aspects of the mail as postage paid, weight, etc., are consistent with the information provided by the mailer.

Thus, the apparatus of Figure 2 of O'Callaghan simply measures/determines certain parameters (postage, weight) of the batch of mail submitted by the mailer (paragraph 0029) to the carrier. The measured/determined data can be compared to the mailer supplied data to ensure they are consistent.(0035).

Moreover, the apparatus of O'Callaghan only teaches that the carrier applies a single ID number to the mailpiece so that information about the individual mailpiece can be maintained in a database for future reference (see for example paragraphs 0008, 0017, 0028, 0031, 0036). This ID number is strictly used by the carrier to identify the mailpiece in order to identify a mailpiece file in which the measured/determined parameters are stored (0036). There is simply no teaching or suggestion in O'Callaghan of the claimed unique identifier generated by the sender, its relationship and association to a unique carrier generated identifier, and its use by a sender in tracking a mailpiece without the sender having knowledge of the unique carrier generated identifier.

As support for the Examiner's position that O'Callaghan teaches the sender generated unique identifier, its relationship to the carrier generated unique identifier and its use by a sender in tracking a specific mailpiece, the Examiner refers to paragraphs 0006, 0007, 0010, 0012, 0013. However, none of these paragraphs even remotely teaches or suggests the sender and carrier generated unique indicia and their interrelationship as claimed. Paragraph 0006 describes what information the O'Callaghan device obtains off of the mailpiece including an indicia. There is no mention of any type of unique identifier. Paragraph 0007 only describes an input feed mechanism. Paragraph 0010 only generally describes a mailpiece that can have indicia and barcodes thereon but doesn't describe any type of unique identifier and certainly not the two claimed unique identifiers. Paragraph 0012 discusses parameter rules relative to batches of mailpieces but

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is silent with respect to the claimed unique identifiers. Finally, paragraph 0013 does discuss an identifier for the mailpiece applied by the carrier but doesn't teach or suggest the sender generated unique identifier or its relationship to the carrier unique identifier as recited in claim 1.

Claim 11 is an apparatus claim that incorporates the method of claim 1. The arguments above are applicable to claim 11 in that O'Callaghan does not teach or suggest the sender generated unique identifier, the database that is used to associate the unique sender generated identifier with the carrier unique identifier, or the sensor that obtains the unique sender identifier from the mailpiece and provides location information to the database.

In summary, with respect to independent claims 1 and 11, the O'Callaghan reference does not even come close to teaching or suggesting the claim limitations discussed immediately above.

Claims 5 and 15

Dependent claims 5 and 15 are directed respectively to a method whereby a recipient address is located on a mailpiece by using the detected location of the unique sender generated identifier and a facer/canceler that performs the method step. The Examiner references paragraph 0012 which is completely silent with respect to any type of unique identifier and which also does not teach or suggest using the detected location of a sender unique identifier to determine the location of a recipient address.

Claims 6 and 16

Dependent claims 6 and 16 are respectively directed to (1) obtaining an address which is embedded within the sender generated unique identifier (located on the mail item) and sending information about the location of the mail item to the obtained address; and 2) the structure for performing the above method step. The Examiner refers to paragraph 12 for allegedly teaching these limitations. It is submitted that paragraph 12 doesn't even remotely teach or such these claimed limitations.

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Claims 7 and 17

Dependent claims 7 and 17 are respectively directed to a method step whereby the address embedded in the sender unique identifier is one of an e-mail address, a page number, and a facsimile machine number. The Examiner references paragraph 0033 where it states a mailpiece may have words, characters, or other indicia thereon. Applicants do not deny that mailpieces can have such information. However, the claimed type of address that is embedded within the sender unique identifier is neither taught nor suggested in O'Callaghan.

Claims 8 and 18

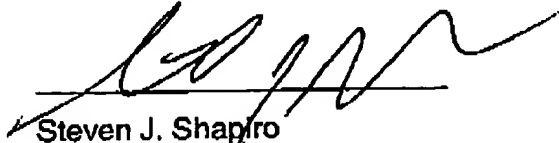
The Examiner submits that the elements of claims 8 and 18 are taught at paragraph 0033 of O'Callaghan. Applicants submit that paragraph 0033 only describes a single carrier generated identifier that is used to identify a mailpiece. It does not teach or suggest a sender generated unique identifier that includes an electronic address and additional data that uniquely identifies the mail item.

Claims not specifically addressed above (2-4, 9-10, 12-14, and 19-21) are considered patentable based on the claims from which they depend and the relevant arguments set forth above.

SUMMARY

It is submitted for each of the reasons enumerated above that claims 1-21 are not anticipated by or rendered obvious in view of the applied reference. Accordingly, the Appellants respectfully request that the Board reverse the Examiner with respect to the rejections set forth in the final Office Action.

Respectfully submitted,



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CERTIFICATION OF FACSIMILE TRANSMISSION

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Via Facsimile to:

Patent and Trademark Office
Attention: Examiner Jon Bass, Group Art Unit: 3639
Facsimile No. 1-571-273-8300

April 6, 2006
Date of Transmission

Steven J. Shapiro
Name of Registered Rep.


Signature

April 6, 2006
Date

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APPENDIX A – Claims

1. A method for tracking through a carrier distribution system a mail item created by a sender, the method comprising the steps of:
 - inducting the mail item into the carrier distribution system, the mail item having thereon a unique sender generated identifier;
 - obtaining the unique sender generated identifier from the mail item during processing of the mail item in the carrier distribution system;
 - assigning a unique carrier generated identifier to the mail item;
 - associating the unique sender generated identifier with the unique carrier generated identifier;
 - the carrier tracking the location of the mail item through the carrier distribution system using the unique carrier generated identifier; and
 - allowing the sender to obtain location information about the mail item using the unique sender generated identifier without the sender having knowledge of the unique carrier generated identifier.
2. The method as recited in claim 1, further comprising applying the unique carrier generated identifier to the mail item.
3. The method as recited in claim 2, further comprising applying the unique carrier generated identifier in a bar code form.
4. The method as recited in claim 2, wherein the unique sender generated identifier is in a bar code form.
5. The method as recited in claim 4, wherein the mail item has a recipient address printed thereon and the unique sender generated identifier is located on the mail item proximate the recipient address and further comprising using the unique sender generated identifier for locating the recipient address.

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6. The method as recited in claim 1, wherein the unique sender generated identifier includes an address and further comprising the carrier obtaining the address from the unique sender generated identifier and supplying to the address information about the location of the mail item.
7. The method as recited in claim 6, wherein the address is one of an e-mail address, a pager number, and a facsimile machine number.
8. The method as recited in claim 1, wherein the unique sender generated identifier includes an electronic address and additional data that uniquely identifies the mail item.
9. The method as recited in claim 1, further comprising uniquely associating the unique sender generated and unique carrier generated identifiers by storing them in a file.
10. The method as recited in claim 9, further comprising reading the unique carrier generated identifier at a plurality of locations throughout the carrier distribution system, storing in the file a date stamp, a time stamp, and a location identifier each time the reading of the unique carrier generated identifier occurs, and associating in the file the date stamp, time stamp, and location identifier with the unique carrier generated identifier and the unique sender generated identifier.
11. A carrier distribution system for tracking a mail item having a unique sender generated identifier thereon, the carrier distribution system comprising:
 - means for reading the unique sender generated identifier from the mail item;
 - means for including a unique carrier generated identifier on the mail item;
 - a data base that associates the unique sender generated identifier with the unique carrier generated identifier;

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at least one sensor that reads the unique carrier generated identifier from the mail item and provides location information to the data base that is associated with the unique carrier generated identifier so that at times when the carrier distribution system receives a location query from an entity about the mail item via submission of the unique sender generated identifier the location information is obtainable from the database without requiring submission of the unique carrier generated identifier by the entity.

19. A system as recited in claim 11, wherein the location information includes a date stamp, a time stamp, and a location identifier.

20. A system as recited in claim 11, wherein the unique sender generated identifier includes an indication of the type of premium service that is requested for the mail item.

21. A system as recited in claim 20, wherein the means for including is a printer.

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APPENDIX B -Evidence

None

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APPENDIX C -Related Proceedings

None

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